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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,928	11/28/2000	Stephen P.A. Fodor	018547036750	9541

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COOLEY GODWARD LLP
THE BOWEN BUILDING
ATTN: THE PATENT GROUP
875 15TH STREET, N.W., SUITE 800
WASHINGTON, DC 20005-2221

EXAMINER

SKOWRONEK, KARLHEINZ R

ART UNIT PAPER NUMBER

1631

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/724,928	FODOR ET AL.	
	Examiner	Art Unit	
	Karlheinz R. Skowronek	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 57-61, 63-69, 71-82, 84-90, 92-98, 100-104, 106-109, 111-113, 115-120, 123-125, 129-132, 135-136, 141-144, 149, 151-152, 154, and 156-162 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 57-61, 63-69, 71-82, 84-90, 92-98, 100-104, 106-109, 111-113, 115-120, 123-125, 129-132, 135-136, 141-144, 149, 151-152, 154, and 156-162 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The examiner of record has changed. Please direct all further correspondence to Karlheinz R. Skowronek whose telephone number is (571) 272-9047.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 February 2006 has been entered.

Claim Status

Claims 57-61, 63-69, 71-82, 84-90, 92-98, 100-104, 106-109, 111-113, 115-120, 123-125, 129-132, 135-136, 141-144, 149, 151-152, 154, and 156-162 are pending.

Claims 1-56, 62, 70, 83, 91, 99, 105, 110, 114, 121-122, 126-128, 133-134, 137-140, 145-148, 150, 153 and 155 are cancelled.

Upon consideration of the claims, the following restriction/election was deemed necessary.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

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- I. Claims 57-61, 63-69, 71-82, 84-90, 92-98, 100-101, 108-109, 111- 113, 115-120, 123-125, 129-132, 135-136, 141-144, 149, 151-152, 154, and 156-162, drawn to systems, software, or programs that acquire data, classified in class 702, subclass 23.
- II. Claim 102-104 and 106-107, drawn to an optical scanning apparatus, classified in class 348, subclass 202.

*If the invention of group I is elected applicant must also elect a single species from each of group A, B, and C. Alternatively, if the invention of group II is elected applicant must also elect a single specie from group D. See **Species Election** below.*

The inventions are distinct, each from the other because of the following reasons:

Inventions of group I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the scanning apparatus of group II could be used to capture photographic images via the optical scanning device rather than the polymer arrays of group I. For example, the invention of group II could be used either for reproduction, modification, or archiving by the capture of images from photographic positive or negative film. Alternatively, the scanning apparatus could be used document imperfections or distinguishing characteristics. For example the device could be used to scan images of molded plastics for imperfections arising during the molding process.

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Both examples for the use of the invention of group II are materially different from the invention of group I.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Species Election

This application contains claims directed to the following patentably distinct species:

- A. i) Specific target polymers that are polypeptides as recited in claim 109;
- A. ii) Specific target polymers that are nucleic acids as recited in claim 113;

- B. i) Specific polymers that are nucleic acid oligonucleotides as recited in claims 80, 88, and 96;
- B. ii) Specific polymers that are nucleic acids that are not oligonucleotides as recited in claim 60, 68, 76, 79, 87, and 95;
- B. iii) Specific polymers that are peptides as recited in claim 61, 69, and 77;

- C. i) Specific array of nucleic acid as recited in claim 120, 123, 132, 142;
- C. ii) Specific array of polypeptides as recited in claim 120, 123, 132, 142;

- D. i) Specific polymer arrays that are nucleic acid arrays as recited in claim 103;

D. ii) Specific polymer arrays that are peptide arrays as recited in claim 104.

Applicant must, if invention I is elected, elect a single species from group A, a single species from group B, and a single species from group C, or if invention II is elected, elect a single species from group D for examination purposes.

The species are independent or distinct because the species of group A, directed to target polymers, have a distinct function from the species of group B, directed to polymers, for example, targets can function as templates for amplification by PCR in the case of nucleic acid or to bind antibodies whereas diverse polymers may not. The Species of Groups A and B are distinct from the species of group C and D because the species of groups C and D are fixed to a solid substrate where the species of group A and B may not be fixed. The species of group A are distinct from each other because they have distinct chemical structures, for example DNA has a distinct chemical structure from a polypeptide. Similarly, the species of group B, species of group C and group D are distinct from each other for a similar reason, the species of group B, C and D have different chemical structures.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 57-59, 63-67, 71-75, 78, 82, 84-86, 89-90, 92-98, 100-101, 102, 106-107, 108, 111-112, 115-119, 124-125, 129-131, 135-136, 141, 143-144, 149, 151-152, 154, and 156-162 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karlheinz R. Skowronek whose telephone number is (571) 272-9047. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MICHAEL BORIN, PH.D
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Michael Borin', is positioned below the printed name and title.